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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/012,204	10/30/2001	Brock W. Callen	10180-002003	5770

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FISH & RICHARDSON PC
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BOSTON, MA 02110

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/012,204

Applicant(s)

CALLEN ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/21/04, 6/23/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 July 2004 has been entered.

Status of Claims

2. Applicant has amended claims 32-33 in the amendment filed 13 August 2004. Claims 1-31 were previously canceled. Thus, claims 32-34 are the only claims that remain pending.

Response to Arguments

3. Applicant's arguments filed 13 August 2004 have been fully considered but they are either not persuasive or moot based upon the new grounds of rejection.

4. Applicant has amended claim 32 in an effort to overcome the 35 USC § 101, however, these amendments do not overcome the rejection for the following reasons.

With respect to claims 32-34, applicant argues that the claims have been amended and now provide a concrete result since reducing the durational risk is the result of an algorithm performed by a computer and reducing the durational risk reduces the cost of providing the insurance. Examiner respectfully disagrees with this assertion and notes that, although the claim states that the durational risk is reduced, there still does not appear to be a concrete result. The claim recites storing results related to a scripted interaction with a terminated employee which are useful in placing the employee in a new job, however, this does not appear to be a concrete result. It is not clear how the mere storing of information directly reduces the cost of providing the insurance. The durational risk does not appear to be a concrete

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number or other result that is a result of some particular calculation or algorithm performed by the computer, and therefore, is not directed to statutory subject matter. Applicant contends that the concrete result is a reduction of the cost of providing the insurance, however, there is nothing recited in the claim related to reducing the cost of providing the insurance.

Information Disclosure Statement

5. The information disclosure statement filed 21 June 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but some of the information referred to therein has not been considered. The non-patent literature references crossed off by the examiner have not been considered by the examiner since no copy was provided.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 32-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to

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be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

- (a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:
 - i. the utility need not be expressly recited in the claims, rather it may be inferred.
 - ii. if the utility is not asserted in the written description, then it must be well established.
- (b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.
- (c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention is in the technological arts since a computer system is used to assemble a prescribed interaction, however, claim 32 does not appear to produce a concrete result since the result cannot be assured. There is no indication or limitation in the claim that would

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suggest the type of information that is accumulated in order to make the stored results concrete. Also, this information is stored, however, does not appear to be provided to any individual or activity in order to realize some practical application of the invention and, therefore, appears to be an abstract idea. Furthermore, although the claims state that the durational risk is reduced, there still does not appear to be a concrete result. The claim recites storing results related to a scripted interaction with a terminated employee which are useful in placing the employee in a new job, however, this does not appear to be a concrete result. It is not clear how the mere storing of information directly reduces the cost of providing the insurance. The durational risk does not appear to be a concrete number or other result that is a result of some particular calculation or algorithm performed by the computer, and therefore, is not directed to statutory subject matter. Thus, for these reasons, claims 32-34 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parrish et al, U.S. Patent No. 5,416,694 in view of Feldman et al, "Managing Layoffs: Experiences at the Challenger Disaster Site and the Pittsburgh Steel Mills" and Lee, "Outplacement: Throwing Them Life Preservers" and "Voice Processing: MCI Delivers Automated Employment Interviewing for the Retail Industry – NetworkMCI Interview Queries Prospects via Phone; Provides Real-Time, Confidential Results" [hereinafter referred to as MCI].

As per **Claims 32-34**, Parrish et al disclose storing information about the qualifications of an employee planning an occupational readjustment (Figure 1; Col. 3, lines 40-45; Col. 5, lines 50-63);

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accumulating information as a result of interviewing the participant which is useful in placing the employee in a new job (Col. 3, line 55-Col. 4 line 5) and assembling and storing this information (Col. 5, lines 50-63), storing information about available jobs (Col. 3 line 65-Col. 4 line 5; Col. 5, lines 17-25) and matching the stored information (Col. 1, lines 60-68; Col. 2, lines 20-25 and 47-52; Col. 5, lines 18-25; Col. 6, lines 7-30).

Parrish et al, however, fail to explicitly disclose assembling a prescribed interaction to enable an administrator to accumulate information useful in placing the employee in a new job. MCI discloses an automated tool for screening and gathering information about job applicants and further discloses network-based computer software for implementing a predefined script that immediately captures responses for up to 60 predefined questions. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Parrish et al and utilize a predefined script when interviewing prospective applicants as taught by MCI. MCI provides motivation by indicating that this gives employers a better, faster and more efficient method to screen and quickly identify the best prospects for a job.

Parrish et al, however, fail to explicitly disclose that the method is used for employees that have been non-voluntarily terminated. Feldman et al disclose that terminated employees should be provided with outplacement assistance such as career counseling sessions and direct placement assistance to help employees locate job opportunities (Pages 4-5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Parrish et al and include this type of job placement service for employees that have been terminated. Parrish et al indicates that the invention is used for occupational readjustment suggesting that it may be used for employees that have lost a job or are looking for a job for various reasons. Feldman et al also provides motivation by indicating that providing outplacement services would help minimize the negative effects of layoffs on both the employees and the organization (Pages 1-2).

Parish et al further fail to disclose reducing a durational risk associated with benefits to be paid under an insurance product that provides termination benefits to employees who are non-voluntarily terminated from employment by an employer. Lee discloses that outplacement services benefit

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terminated employees. Outplacement services provides counseling, skills assessment, assistance in resume preparation, job search skill planning along with other services that help terminated employees find a new job. Lee further teaches that these services tend to help employees find new jobs faster than they would on their own, thereby reducing continuing pay and insurance benefits costs to employers. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Parish et al and include outplacement services as part of an insurance product to provide termination benefits and to use outplacement services in an effort to reduce the benefits that would be paid as taught by Lee.

Conclusion

10. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Iliff discloses performing a prescribed interview to collect information

12. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- McGovern et al disclose an employment recruiting system and teach a method of monitoring employment advertisements for a job seeker and automatically notifying the job seeker when a position is suitable

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- Walker et al disclose a method for establishing anonymous communications between job seekers and employers seeking job applicants
- Clark et al disclose an automated method for selecting personnel matched to job criteria
- Nobile "Outplacement Counseling: Minimizing Legal Liability" discloses providing outplacement services to terminated employees including job search strategies for ultimately landing a new position
- Mishra et al, "Preserving Employee Morale During Downsizing" disclose that providing outplacement services such as job placement and job bank services helps to preserve employee morale.
- Lisoski, "When Layoffs are Inevitable – Do Them Right", discloses providing job assistance to terminated employees such as effective job searching techniques, career counseling and providing assistance in finding new employment.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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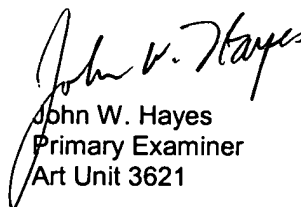
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

September 10, 2004